

**REMARKS**

**Formalities**

With this Amendment, Applicants cancel Claims 2 and 9. Therefore, Claims 1, 3-8, and 10-18 are all the claims currently pending in the present Application.

The Examiner acknowledges Applicants' claim to foreign priority and the receipt of the certified copy of the priority document. The Examiner also returns a signed and initialed copy of the PTO-Form 1449 submitted with the May 25, 2004 IDS.

**Claim Rejections**

Claims 1-11, 13, 17, and 18 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Lambert, U.S. Patent No. 6,288,815 ("Lambert"). Claims 14-16 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Lambert, in view of Bierhuizen et al., U.S. Patent No. 6,839,095 ("Bierhuizen"). Claim 12 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Lambert, in view of Dewald, U.S. Patent Publication No. 2002/0135862 ("Dewald").

**Claim 1.** Regarding Claim 1, Applicants submit that Lambert fails to disclose or suggest at least a scrolling unit including a plurality of spirally-arranged lens cells, as recited. Additionally, Applicants submit that Lambert fails to disclose or suggest a color separator disposed between a color scanner and a light valve, as recited. Applicants note that the dichroic cube of Lambert, which the Examiner refers to as disclosing the claimed color separator, is disposed between the light source and the scanning element.

Therefore, in view of at least the above, Applicants submit that Lambert fails to anticipate Claim 1, and respectfully request that the rejection of Claim 1 be reconsidered and withdrawn.

**Claims 3-8 and 10-18.** Regarding Claims 3-8 and 10-18, Applicants submit that these claims are patentable at least by virtue of their dependence on Claim 1.

Additionally, regarding the “phase offset value” of Claim 3 and the “reference phase generator” and “reference phase signal” of Claim 4, the Examiner refers to col. 9, lns. 48-56 of Lambert. This section of Lambert discusses that a height difference is translated into a phase pre-correction for the scanning element. Evidence of inherency in a reference “must make it clear that the missing descriptive matter is *necessarily present* in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.”<sup>1</sup> It appears, therefore, that this portion of Lambert fails to disclose that a “phase offset value,” a “reference phase generator,” or a “reference phase signal,” as recited are inherent. Further, regarding the more particular limitations of Claims 5-8, it also appears that the disclosure of Lambert fails to inherently require the specific limitations of these claims. Specifically, regarding Claim 5, there is no disclosure which would require “adjusting phases of scanning the color bars on the light valve until a bar of

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<sup>1</sup> *Continental Can Co. USA Inc. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991) (*emphasis added*). “Inherency, however may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Id.* (*citing In re Oelrich*, 666 F.2d 578, 581 (Fed. Cir. 1981) (*quoting Hansgirg v. Kemmer*, 102 F.2d 212, 214 (C.C.P.A. 1939))); *see also Scaltech Inc. v. Retec/Tetra L.L.C.*, 51 U.S.P.Q.2d 1055, 1059 (Fed. Cir. 1999); and *In re Robertson*, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). Even if the prior art reference could have equally been used or made with only two possibilities, a patent claim which claims one of the two possibilities will not be anticipated because that limitation was not “necessarily” present in the prior art disclosure. *See Finnigan Corp. v. I.T.C.*, 51 U.S.P.Q.2d 1001, 1009-10 (Fed. Cir. 1999) (holding that a prior art reference that disclosed a set-up for performing only resonance or nonresonance ejection was insufficient to show, clearly and convincingly, that nonresonance ejection was inherently taught by the prior art reference).

a specific color bar is modulated by only image information corresponding to the specific color.” Specifically, regarding Claims 6-8, there is no disclosure which would require that a phase offset value be stored in non-volatile memory, as recited. Further, there is no disclosure in Lambert of any non-volatile memory.

Therefore, in view of at least the above, Applicants submit that Claims 3-8 and 10-18 are patentable over the cited combination of references and respectfully request that the rejections thereof be reconsidered and withdrawn.

**Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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